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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,951	02/15/2000	Simon Robert Walmsley	AUTH08US	5608

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EXAMINER

DAVIS, ZACHARY A

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/505,951

Applicant(s)

WALMSLEY ET AL.

Examiner

Zachary A. Davis

Art Unit

2137

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.


EMMANUELLE L. MOISE
SUPERVISORY PATENT EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments are not persuasive.

First, Applicant argues that the combination of Sony and Spies does not describe, teach, or suggest all of the limitations of Claim 1, with particular emphasis on the limitation of "encrypting the decrypted random number by the symmetric encryption function using A SECOND KEY AND RETURNING IT TO THE TRUSTED AUTHENTICATION CHIP" (see page 2 of the present response, item 2 of the list at the middle of the page; emphasis in original). The Examiner respectfully disagrees, and notes that Sony and Spies clearly disclose encrypting the decrypted random number using a second key (Sony, column 9, lines 31-48, noting especially lines 42-46; see also Figure 9) and returning the re-encrypted random number to the trusted authentication chip (i.e. first apparatus) (see Sony, column 9, line 57-column 10, line 2; see also Figure 9).

Second, Applicant appears to allege that there is an inconsistency between the Examiner's previous statements (1) that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references (for example, at page 3 of the Office action mailed 18 January 2006) and (2) that Applicant's proposed combination of the references "is mere speculation, and would result only from naively combining all of the limitations recited" (at page 5 of the abovementioned Office action). However, the Examiner disagrees that there is an inconsistency between the statements; the statements were directed to different arguments, noting that the arguments addressed following statement (1) on page 4 of the Office action were directed to references individually and the arguments referred to by statement (2) and addressed on page 5 of the Office action were directed to a bodily combination of the references. The Examiner merely intended, by statement (2) above, to draw to Applicant's attention that although the specific arguments referred to were in fact directed to a combination of references, the manner of Applicant's combination of the references (bodily incorporating the features of the Spies into the disclosure of Sony) was not that relied upon by the Examiner (application of the general teachings of Spies to the disclosed method of Sony).

To clarify, the Examiner further notes that statement (2) referred specifically to Applicant's argument in the previous response (received 03 November 2005) where Applicant was attempting to show that the result of combining the references by Sony and Spies would necessarily result in a combination that was derived only from bodily incorporating limitations of the method in Spies as additional steps in the method taught by Sony (the specific combination quoted from page 3, paragraph 1 of the response received 03 November 2005). The main point of that argument (also stated at page 5 of the abovementioned Office action) is that the test for obviousness is NOT whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference (noting that herein, "bodily incorporation" and "structure" are figurative as regards a method); NOR is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test for obviousness is what the combined TEACHINGS of the references would have suggested to those of ordinary skill in the art. The Examiner again notes that Spies was relied upon for a general TEACHING of the use of a signature of a general "document" and encrypting both the document and the signature under the same symmetric key (see Spies, column 12, lines 6-27) for the purpose of authenticating the sending of the document (Spies, column 13, lines 26-32). To one skilled in the art considering the authentication method disclosed by Sony and the above TEACHING of Spies, it would have been obvious to use a signature of the random number in Sony to further provide authentication of the random number, as taught by Spies.

Therefore, the Examiner maintains the rejections set forth in the previous Office action.

Continuation of 13. Other: The Examiner notes that Applicant's arguments are again limited to Claim 1, and no specific arguments have been presented that are directed to Claims 2-20.